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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/590,592 06/08/00 JONES

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EXAMINER

LUKTON, D

ART UNIT

PAPER NUMBER

1653

DATE MAILED:

07/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/590,592

Applicant(s)  
Jones

Examiner  
David Lukton

Art Unit  
1653



-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Jan 16, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-53 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☒ Claims 1-53 are subject to restriction and/or election requirements.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other:

A restriction is imposed, as set forth below. First, however, the following subgenera are defined:

**G1:** this subgenus is equivalent to the genus defined in claim 16.

**G2:** In this subgenus, the presence of oxyalkylene groups in the molecule is required.

**G3:** This subgenus is limited to that which is defined by claims 11 and 12, with the proviso that G1 is excluded.

\*

Restriction to one of the following inventions is required under 35 U.S.C. §121 (BAM = "biologically active molecule"):

1. Claims 1-10, drawn to compounds in which G2 is included, and both G1 and G3 are excluded.
2. Claim 5, drawn to compounds in which all of the following are excluded: G1, G2 and G3.
3. Claims 11-15, drawn to compounds in which G2 is included, and G1 is excluded.
4. Claims 11-13, 15, drawn to compounds in which G2 is excluded, and G1 is excluded.
5. Claims 16-37, drawn to compounds.
6. Claims 40-42, 48, 50-53, drawn to a conjugate between Group 1 molecules and a BAM.
7. Claims 43 and 49, drawn to a conjugate between Group 3 molecules and a BAM.
8. Claims 43 and 49, drawn to a conjugate between Group 4 molecules and a BAM.
9. Claims 44-45, drawn to a conjugate between Group 5 molecules and a BAM.

Claims 38-39, 46, 47 are not grouped. These claims will be joined with the elected group.

The claimed inventions are distinct.

Claim 5 has been bisected into two groups, one which requires the presence of oxyalkylene groups, and one which does not. Similarly, claims 11-15 have been bisected into two groups, one which requires the presence of oxyalkylene groups, and one which does not.

Group 1 excludes the compounds of claim 16. Nevertheless, flexibility in this restriction is likely, if agreement can be reached, prior to the final action, as to what is novel and what is not. For example, if applicants were to elect Group 1, the remaining claims (other than 38-39, 46, 47) would initially be withdrawn from consideration. However, if, in response to the first Office action on the merits (FAOM), applicants were to request a change in the elected group to Group 5, this request would likely be granted. On the other hand, if applicants were to elect Group 1, and to subsequently traverse a §103 rejection until after the final Office action, then the window of opportunity to change the election to Group 5 would close.

In the event that applicants elect one of Groups 1-4 or 6, and claims are determined to be novel prior to the final Office action, the corresponding claims drawn to a conjugate will be rejoined. If agreement as to novelty is not reached until after the final Office action, the corresponding claims drawn to a conjugate may or may not be rejoined, depending on circumstances.

Claim 5 is the broadest claim. If applicants were to elect Group 2, and claim 5 were

found to be allowable (prior to the final Office action) without further limitation, then the restriction would be withdrawn in its entirety. Similarly, if applicants were to elect Group 2, and those claims were found to be allowable (prior to the final Office action) without further limitation, then all claims (other than claim 5) would be rejoined therewith.

Applicant is advised that for the response to this requirement to be complete, an election of the invention to be examined must be indicated, even if the requirement is traversed (37 C.F.R. 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

In addition to the foregoing, applicants are required under 35 U.S.C. §121 to elect a disclosed specie for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. A "specie" is a specific compound, of a fully defined structure.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.



Serial No. 09/590,592  
Art Unit 1653

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



DAVID LUKTON  
PATENT EXAMINER  
GROUP 1600